



UNITED STATES PATENT AND TRADEMARK OFFICE

44
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,265	07/12/2001	Robert D. Kern	297.003	2035

23598 7590 10/02/2002

BOYLE FREDRICKSON NEWHOLM STEIN & GRATZ, S.C.
250 E. WISCONSIN AVENUE
SUITE 1030
MILWAUKEE, WI 53202

EXAMINER

MOHANDESI, IRAJ A

ART UNIT	PAPER NUMBER
----------	--------------

2834

DATE MAILED: 10/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/904,265

Applicant(s)

KERN ET AL.

Examiner

Iraj A Mohandesi

Art Unit

2834

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 18-20 is/are rejected.
- 7) ☒ Claim(s) 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 12 July 2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 1 recites the limitation the inlet flow in line 11. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. **Claims 1,2,4-10,12-16,18-20** are rejected under 35 U.S.C. 102(e) as being anticipated by **Grizzle US patent 6,376,944**.

Grizzle'944 disclosing a generator structure (12) comprising, an enclosure (14) having first and second spaced sidewalls (16,18 Fig. 2, column 1 line 42) interconnected by first and second end walls (20,22 Fig.2 column 1 ,line 43) so as to define an interior for

Art Unit: 2834

receiving an engine (54 ,Fig.1 column 1 line 62) and an alternator (56,column 1 line 63) ,a roof structure (24,Fig.1,2, column1 ,line 44) positioned on the enclosure (Fig. 1,2) and including an eave portion (30, Fig. 2,column 1,line 45) having an inlet communicating with the ambient air external of the generator structure(Fig. 2), an outlet (87,28,Fig. 1 column 2 line 35-36) communicating with the interior of the enclosure and an input flow path there between (Fig. 2.), and an attic (inside 87and 40, Fig. 2 column3,line10-12) portion having an inlet communicating with the interior of the enclosure, an outlet (32) communicating with ambient air external of the generator structure (Fig.2) and an exit flow path there between, and an air flow generator positioned within the interior of the enclosure for drawing ambient air through the inlet flow path in the eave portion of the roof structure into the interior of the enclosure (Fig. 1 see the marked air flow path), a muffler (66, Fig.1, column 2,line 23) operatively connected to the engine, the muffler positioned within the exit flow path.(Fig.1), an air flow a fan(58 column 2 line 3),a base (57,Fig.1,column2,line 12) ,a separation panel (76 ,column 2, line 31).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claim 3,11** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Grizzle'944** in view of **Webber US Patent 4,479,460**.

Grizzle'944 disclosing a generator structure (12) comprising, an enclosure (14) having first and second spaced sidewalls (16,18 Fig. 2, column 1 line 42) interconnected by first and second end walls (20,22 Fig.2 column 1 ,line 43) so as to define an interior for receiving an engine (54 ,Fig.1 column 1 line 62) and an alternator (56,column 1 line 63) ,a roof structure (24,Fig.1,2, column1 ,line 44) positioned on the enclosure (Fig. 1,2) and including an eave portion (30, Fig. 2,column 1,line 45) having an inlet communicating with the ambient air external of the generator structure(Fig. 2), an outlet (87,28,Fig. 1 column 2 line 35-36) communicating with the interior of the enclosure and an input flow path there between (Fig. 2.), and an attic (inside 87and 40, Fig. 2 column3,line10-12) portion having an inlet communicating with the interior of the enclosure, an outlet (32) communicating with ambient air external of the generator structure (Fig.2) and an exit flow path there between, and an air flow generator positioned within the interior of the enclosure for drawing ambient air through the inlet flow path in the eave portion of the roof structure into the interior of the enclosure (Fig. 1 see the marked air flow path), a muffler (66, Fig.1, column 2,line 23) operatively connected to the engine, the muffler positioned within the exit flow path.(Fig.1), an air flow a fan(58 column 2 line 3),a base (57,Fig.1,column2,line 12) ,a separation panel (76 ,column 2, line 31).

However **Grizzle'944** discloses all limitation of the claim except a radiator positioned between the engine and the air flow.

Webber'460 discloses a radiator positioned between the engine and the air flow (Fig.1) for the purpose of improving the engine cooling system.

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine **Grizzle'944** engine with a radiator positioned between the engine and the air flow as taught by **Webber'460** for the purpose of improving the engine cooling system.

It would also been obvious to add a second generator to the structure , since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Allowable Subject Matter

8. Claim 17 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Iraj A Mohandesi whose telephone number is (703)305-3242. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nestor Ramirez can be reached on 703-308-1371. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9314 for regular communications and (703)872-9314 for After Final communications.

Application/Control Number: 09/904,265
Art Unit: 2834

Page 6

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)306-0377.

IM
September 26, 2002


NESTOR RAMIREZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800